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IN THE

# Supreme Court of the United States

October Term, 1976

No. .....

INTERNATIONAL RECTIFIER CORPORATION, *et al.*,

*Petitioners,*

*vs.*

PFIZER, INC.,

*Respondent.*

## VOLUME I

**Petition for Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.**

**(Appendix in Volume II)**

PETER R. COHEN,
9601 Wilshire Boulevard, Suite 200,
Beverly Hills, Calif. 90210,
(213) 278-4011,
*Attorney for Petitioner.*

Parker & Son, Inc., Law Printers, Los Angeles. Phone 724-6622

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INTERNATIONAL RECTIFIER CORPORATION, *et al.*,
*Petitioners,*

*vs.*

PFIZER, INC.,
*Respondent.*

**Petition for Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.**

International Rectifier Corporation ("IRC")[1] (hereinafter referred to as "Petitioner") prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit entered in the above entitled case on June 16, 1976.

## I
## Opinions Below.

The Opinion of the United States Court of Appeals for the Eighth Circuit (A. pp. 95-128) is reported at 190 U.S.P.Q. 273. The Opinion of the United States District Court, District of Minnesota, Fourth Division (A. pp. 2-95) is reported at 186 U.S.P.Q. 511 (D. Minn. 1975).

[1]International Rectifier Corporation and its four subsidiaries, Rachelle Laboratories Italia S.p.A., Rachelle Laboratories, Inc., Rachelle Pharmaceuticals International, S.A., and Rachelle Laboratories (Philippines), Inc., are hereinafter jointly referred to as "IRC".

## II

## Jurisdiction.

The undated Opinion of the United States Court of Appeals for the Eighth Circuit was entered on June 16, 1976. A timely request for an extension of time within which to file this petition was granted on August 27, 1976 extending petitioner's time to and including October 14, 1976. The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

## III

## Question Presented.

Whether in a patent case, where the issue is fraudulent and inequitable conduct before the Patent Office, the patent applicant's subjective intent to commit a fraud or engage in inequitable conduct is either an element of proof or a defense.

## IV

## Statutes Involved.

This case involves 35 U.S.C. §§102, 103 and 112.

## V

## Statement of the Case.

On January 11, 1973, Pfizer, Inc. ("Pfizer") filed suit against IRC and its customer, USV Pharmaceutical Corporation ("USV") (hereinafter both referred to as "defendants") for alleged infringement of its doxycycline patent, U.S. No. 3,200,149. Defendants' answers allege, insofar as here material, that the doxycycline patent was procured by fraudulent and inequitable conduct before the Patent Office and is therefore invalid and unenforceable.



Pfizer filed the doxycycline patent application in May, 1961, and after three Patent Office Rejections and five Amendments by Pfizer, the patent finally issued in August of 1965.

On February 11, 1975, defendants moved for partial summary judgment seeking, among other things, to establish that in prosecuting the patent application, Pfizer had withheld certain facts and misrepresented other facts relevant to a variety of different issues of patentability, and that both individually and cumulatively, Pfizer's conduct was fraudulent and inequitable, and that hence its doxycycline patent was invalid and unenforceable.

Defendants' motion was based almost entirely upon Pfizer's contemporaneous documents and the affidavit of one of the Patent Examiners. Pfizer's opposition (which did not deny the facts established by its contemporaneous documents and by the affidavit testimony of the Patent Examiner) was based entirely on the ultimate legal effect of its conduct before the Patent Office and upon the affidavits of its scientists and patent agents which sought to raise factual issues by proclaiming their "good faith" and "good faith beliefs" concerning their withholding of certain facts and their misrepresentation of other facts, to the Patent Office.

On July 16, 1975, the District Court, in an 80 page Opinion, granted defendants' motion for partial summary judgment, finding that over 150 uncontroverted facts existed (A. p. 9). From these uncontroverted facts, the District Court concluded that there was no genuine issue of material fact as to five separate frauds committed on the Patent Office. Of these five separate frauds, the District Court found that four were material

to an issue of patentability at some time during the prosecution of the patent application and constituted inequitable conduct, and that one was so material throughout the prosecution of the patent application, that "but for" this fraud, the patent would not have issued with the broad claims which were in fact granted. Finally, the District Court concluded that Pfizer's cumulative course of conduct before the Patent Office constituted fraudulent conduct, or at the very least a calculated recklessness about the truth, for the purpose of obtaining a patent containing the broadest possible product and process claims, which conduct also barred enforcement of the doxycycline patent.

In finding that Pfizer's conduct was fraudulent and inequitable, the District Court found only that Pfizer's withholding of certain facts and its misrepresentation of other facts was "deliberate" in that Pfizer, with knowledge of the existence of the true facts, had intentionally withheld, or misrepresented, facts which *were* material to different issues of patentability; and that whether or not Pfizer also had the accompanying subjective intent to defraud the Patent Office was irrelevant. Thus, the District Court expressly stated that:

> ". . . Pfizer's assertions of *good faith* belief, based on its scientists', patent agents', and attorneys' *subjective state of mind,* in misrepresenting to and withholding relevant facts from the Patent Office does not create any genuine issue of material fact." (A. p. 14) (Emphasis added).

The District Court's conclusion that the "deliberate" misrepresentation or withholding of relevant facts without inquiring into the subjective intent of the patentee as to whether or not a fraud was intended is the



crux of the difference between the District Court's judgment that the patent is unenforceable and the Eighth Circuit's reversal thereof. In this regard, the Eighth Circuit, in reversing the judgment, initially stated that "[t]he scientific issues at stake are of such moment that all parties should be permitted to present their evidence fully in a plenary trial not restricted to a trial by affidavit" (A. p. 101); but then the Eighth Circuit based its reversal as to each of the issues relating to Pfizer's conduct before the Patent Office on the alleged existence of genuine issues of material fact concerning ". . . intent, good faith and other subjective feelings . . ." (A. p. 103), such as ". . . the states of mind of Pfizer's scientists and patent counsel . . ." (A. p. 113), and Pfizer's "willfulness" (A. p. 116) concerning its uncontroverted conduct before the Patent Office.

The issue of "deliberate" in the sense of intending to do an act versus "deliberate" in the sense of intending to do an act with the accompanying motive of also intending to commit a fraud was *the* issue before the Eighth Circuit.

However, the Eighth Circuit also based its reversal upon the existence of ". . . additional issues of technical fact . . . [which] are unsuited for summary resolution without the benefit of live expert testimony and cross-examination in a plenary trial." (A. p. 113) and "the examiner's understanding of technical facts critical to evaluating Pfizer's conduct" (A. p. 116). This additional ground was *not* an issue on appeal.

In its Opinion, the District Court painstakingly set forth the undisputed "Facts Respecting Technical Terms and Concepts" (A. pp. 27-31), all of which were taken

from Pfizer's affidavits. Likewise, in its Opinion, the Eighth Circuit summarized with precise and complete understanding its summary of the technical facts. Thus, both the District Court and the Eighth Circuit correctly understood and enunciated the technology necessary to appreciate the factual issues. Neither Pfizer, in its appeal from the District Court's judgment, nor petitioners, in the within petition, claim that the technical facts are anything other than as set forth by both lower lower courts. (See further discussion in Point VI 3, *infra*).



## VI
## Reasons for Granting the Writ.

### 1. The Remedy of Summary Judgment Should Be Available Where the Uncontroverted Facts Show That the Patent Applicant Deliberately Withheld Facts From or Misrepresented Facts Presented to the Patent Office.

In *Ballantyne Instruments & Electronics v. Wagner,* 345 F.2d 671 (6th Cir. 1965), the court said that "the public interest in every patent case requires that suits involving the validity of patents should be speedily determined [by motions for summary judgment if appropriate]." This Court in *Lear Inc. v. Adkins,* 395 U.S. 653 (1969) also declared that "dilatory court tactics", particularly in patent cases, should be discouraged to protect the public against improvidently granted patent monopolies.

See also *Hazel-Atlas Glass Co. v. Hartford-Empire Co.,* 322 U.S. 238 (1944), where this Court also stated that where the uncontroverted evidence establishes fraud, "[n]othing in reason or precedent requires such a cumbersome and dilatory procedure" as a plenary trial.

In accordance with the policy of speedily terminating unwarranted patent monopolies, the Courts of Appeal have held that summary judgment is as appropriate in patent cases as it is in any other case. *Steigleder v. Eberhard Faber Pencil Co.,* 176 F.2d 604 (1st Cir. 1949), *cert. denied,* 338 U.S. 893; *Kaz Manufacturing Co. v. Chesebrough-Pond's, Inc.,* 317 F.2d 679 (2nd Cir. 1963); *Alco Kar Kurb, Inc. v. Ager,* 286 F.2d 931 (3rd Cir. 1961); *Methode Electronics, Inc. v. Elco Corp.,* 385 F.2d 138 (3rd Cir. 1967); *Smith v. General Foundry Machine Co.,* 174 F.2d 147 (4th

Cir. 1949), *cert. denied,* 338 U.S. 869; *Ronel Corp. v. Anchor Lock of Florida, Inc.,* 325 F.2d 889 (5th Cir. 1963); *Bobertz v. General Motors Corp.,* 228 F.2d 94 (6th Cir. 1955), *cert. denied,* 352 U.S. 824 (1956); *A.R., Inc. v. Electro-Voice, Inc.,* 311 F.2d 508 (7th Cir. 1962); *Research Corporation v. Nasco Industries, Inc.,* 501 F.2d 358 (7th Cir. 1974); *Proler Steel Corp. v. Luria Bros. & Co.,* 417 F.2d 272, 273, 274 (9th Cir. 1969).

In following that policy, the District Courts have recently granted summary judgment in patent cases where the uncontroverted facts demonstrated that the patentee procured its patent by fraudulent or inequitable conduct. *Farmer Bros. Co. v. Coca Cola Co.,* 384 F.Supp. 595 (D.C. Cal. 1974); *Interlego, A.G. v. F.A.O. Schwarz, Inc., et al.,* 187 U.S.P.Q. 580 (N.D. Ga. 1975).

In the case at bar, the Eighth Circuit has now made it impossible to obtain a summary judgment in a patent case involving uncontroverted deliberate fraudulent or inequitable conduct upon the Patent Office, by allowing the patentee to force a plenary trial merely by asserting, "I didn't mean it".

**2. Where the Uncontroverted Facts Are That the Patentee Deliberately Withheld Material Facts From or Deliberately Misrepresented Facts Presented to the Patent Office, the Patentee Cannot Avoid Summary Judgment by Simply Asserting That He Did Not Subjectively Intend to Defraud the Patent Office.**

A patent applicant is a fiduciary, and as such has an uncompromising duty of candor which requires the disclosure to the Patent Office of all facts which may



be relevant to an issue of patentability. *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.,* 324 U.S. 806, 814-18 (1945); *Charles Pfizer & Co. v. FTC,* 401 F.2d 574, 579 (6th Cir. 1968), *cert. denied,* 394 U.S. 920 (1969); *Monsanto Co. v. Rohm & Haas Co.,* 312 F.Supp. 778, 798-800 (E.D. Pa. 1970), *aff'd* 456 F.2d 592, 597-99 (3rd Cir. 1972), *cert. denied,* 407 U.S. 934 (1972); *Monolith Portland Midwest Co. v. Kaiser Aluminum & Chemical Corp.,* 407 F.2d 288, 294 (9th Cir. 1969).

This obligation of absolute candor is based upon the fact that the Patent Office has no testing facilities, and must necessarily rely on the applicant for relevant information, *Charles Pfizer & Co. v. FTC, supra,* and the public policy which abhors unwarranted patent monopolies as an illegal burden on free competition, *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., supra; Graham v. John Deere Co.,* 383 U.S. 1, 9 (1966). Hence, given the realities of Patent Office prosecution, the only way to assure that the standards of patentability are properly applied, is to hold the applicant to the highest standards of disclosure and candor, and fashion rules which are designed to assure that those standards are fully and faithfully met.

In fashioning such rules, the Courts of Appeal have, over the years, appeared to create more than one rule. The more recent and increasingly applied rule does not require a party attacking the validity of a patent to prove that the patent would not have issued as a matter of law "but for" the misrepresentation or concealment. Rather, that rule requires only that the misrepresentation or concealment be material, *i.e.,* relevant to an issue of patentability. *Monsanto v. Rohm*

*& Haas Co.*, 312 F.Supp. 778, 798-800 (E.D. Pa. 1970), *aff'd* 456 F.2d 592, 597-99 (3rd Cir. 1972), *cert. denied*, 407 U.S. 934 (1972); *Beckman Instruments, Inc. v. Chemtronics, Inc.*, 428 F.2d 555, 556 (5th Cir. 1970), *cert. denied*, 400 U.S. 956 (1970); *Monolith Portland Midwest Co. v. Kaiser Aluminum & Chemical Corp.*, 407 F.2d 288, 294 (9th Cir. 1969); *SCM Corp. v. Radio Corp. of America*, 318 F.Supp. 433 (S.D.N.Y. 1970); *United States Movidyn Corp. v. Hercules, Incorporated*, 388 F.Supp. 1146 (D. Minn. 1975); *Timely Products Corp. v. Arron*, 523 F.2d 288, 298 (2nd Cir. 1975); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 U.S.P.Q. 673, 711 (D. Minn. 1973).

As stated above, the District Court here found that of the five separate frauds committed on the Patent Office, four met the newer "materiality" standard and one satisfied the older "but for" standard. In addition, as also explained, *supra*, the District Court also cumulated the five different frauds as a sixth and separate ground of unenforceability, *Monolith Portland Midwest Co. v. Kaiser Aluminum & Chemical Corp., supra; Intermountain Research and Engineering Co. v. Hercules, Inc.*, 171 U.S.P.Q. 577, 631 (C.D. Cal. 1971); *Dresser Industries, Inc. v. Eltra Corp.*, 186 U.S.P.Q. 329, 357 (N.D. Ohio 1975).

In reversing the District Court's judgment, the Eighth Circuit did not adopt or apply either the older "but for" rule or the newer "materiality" or "cumulative materiality" rules. To the contrary, the Eighth Circuit said only that "[w]e express no opinion as to Pfizer's conduct before the Patent Office nor on the merits of the legal and factual issues of patent validity" (A. p. 101), except to say that ". . . the District Court



adopted a far reaching interpretation . . . [which] . . . imposes an unworkable standard of conduct upon the patent applicant and expands the inequitable conduct defense beyond legitimate limits." (A. p. 105). In so stating, the Eighth Circuit engrafted upon the legal standard, whatever it may be, the further requirement that the subjective intent of the patentee to commit or not to commit a fraud must be determined, and which, according to the Eighth Circuit, can only be resolved by a plenary trial.

Stated differently, since the uncontroverted facts prove "but for" *and* "materiality" *and* "cumulative materiality", it appears that the Eighth Circuit is requiring the patentee's subjective intent and good faith to be resolved in any event. Thus, the precise issue raised by the Eighth Circuit is *not* whether the substantive rule should be "but for" or "materiality" or "cumulative materiality" but whether subjective intent to deceive or subjective lack of intent to deceive is a necessary element of proof or a defense.

We now direct ourselves to this isolated issue—an issue which this Court has not yet decided, and which has been decided in one way by the Third and Ninth Circuits and in another way by the Eighth Circuit in this case.

In *Monolith Portland Midwest Co. v. Kaiser Aluminum & Chemical Corp., supra*, the Ninth Circuit held that where a patent applicant fails to meet his uncompromising duty of candor, it is not necessary to show a specific intent to deceive the Patent Office in order to render the patent unenforceable. The Court there ruled that the patentee's assertion that ". . . it believed in good faith" that the prior art which it withheld

from the Patent Office did not anticipate the issued claims was inadequate to excuse the patentee's failure to "disclose openly and fully the underlying facts" since, "[a]t the least, Monolith knew that those facts *might affect* the patentability of the invention." (407 F.2d at 295; emphasis added).

Similarly, in *Monsanto Co. v. Rohm & Haas Co., supra,* the Third Circuit approved the District Court's statement that ". . . even if the decision not to disclose was motivated by nothing more than bad judgment as to the materiality of the information, the patent must still be rejected. We hold that a specific intent to deceive is not necessary to bar a patent when there is evidence of a deliberate withholding of material information." (456 F.2d at 601 n. 14).

Likewise, in *Robbins Company v. Lawrence Manufacturing Company,* 482 F.2d 426 (9th Cir. 1973) the Ninth Circuit reversed the trial court's denial of a motion for summary judgment precisely because the trial court relied on the inventors' affidavits concerning their "subjective intent". The Ninth Circuit held, at page 431:

> "An inventor's testimony of his subjective intent has no probative force against overwhelming evidence to the contrary. . . . Such testimony is insufficient to raise a genuine issue of material fact to defeat an adverse summary judgment."

The rationale of *Monolith, Monsanto* and *Robbins* is clear. In a fiduciary relationship requiring complete disclosure to the Patent Office of all facts which may be relevant to an issue of patentability, the patentee cannot be permitted to say, after procuring the patent, that he, exercising his good faith subjective judgment, independently determined that the withheld or misrepresented facts were neither material nor relevant. It is not for the patent applicant to decide "in good faith" what is or is not material or relevant to a statutory criterion of patentability. All facts which may be relevant to an issue of patentability must be submitted to the Patent Office to enable it to independently make the decisions with which it is charged under the law. The strong public policy against improvidently granted patent monopolies cannot tolerate any lesser standard which permits the patent applicant to substitute his decision for that of the Patent Office. *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.,* 324 U.S. 806 (1945). Thus, in *Precision,* the court said:



> "This duty [of candor] is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in this way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud' " (324 U.S. at 818).

Once having submitted all of the facts which are relevant to an issue of patentability to the Patent Office, the patent applicant has two choices—he can either persuade the Patent Examiner that his position is correct, or he can appeal. *I.T.S. Rubber Co. v. Essex Rubber Co.,* 272 U.S. 429, 433 (1926). The patent applicant does not, of course, have the third

option of himself deciding which facts are truly relevant to an issue of patentability and then either withholding those facts or misrepresenting them.

If the Eighth Circuit's holding in this case—that the patentee's subjective intent to commit a fraud is an issue—is allowed to stand, then the function of the Patent Office and the policy against improvidently granted patents would indeed be subverted. For example, if the trier of fact determined that the patentee in "good faith" believed that certain withheld facts, or prior art, were immaterial to patentability, the patent could be held valid even though the court might find that the withheld facts, or prior art, *were* material to an issue of patentability as a matter of law. The Eighth Circuit's opinion therefore creates the third option which this Court's opinion in *I.T.S. Rubber Co. v. Essex Rubber Co., supra,* forbids.

The facts of this case on but a single issue perfectly illustrate the unworkability of the new requirement added by the Eighth Circuit to the legal standards and the anomaly thereby created. Here the District Court found that prior to issuance of the patent all of Pfizer's experiments failed to make ruthenium work as a claimed "preferred" catalyst (A. p. 78, Findings 1-4). The District Court further found that Pfizer did not disclose its failures to the Patent Office (A. p. 78, Finding 5). Finally, the District Court found, relying on the affidavit testimony of the Examiner "that he would have rejected at least the principal process claim (claim 1) of the Doxycycline application under 35 U.S.C. §112" had he known of Pfizer's experimental failures[2] (A. p. 78, Finding 6).

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[2]As the Examiner testified: "At all times during the prosecution of the application, I would have been interested in and considered material, any scientific evidence that Pfizer had been unable to successfully employ ruthenium. . . . Had I been informed that such was the fact, I would have rejected at least claim 1 . . . as failing to comply with 35 U.S.C. 112 . . ." (A. p. 130).

In an attempt to escape the devastating effect of this testimony, Pfizer secured another affidavit from the Examiner in which he stated that by use of the words "scientific", he meant "reliable" or "conclusive"; and that the failure of "some experiments" would not preclude claims encompassing such experiments if "investigation" revealed the reasons for the unsuccessful experiments. (A. p. 134). These obvious hypotheses were, of course, inapplicable, as the Examiner was not addressing himself to the fact that *all* of Pfizer's experiments were unsuccessful. Furthermore, there is nothing whatsoever in the record which shows that Pfizer's unsuccessful experiments were unreliable. Moreover, there is also nothing in the record which shows at any time any "investigation" which explained why all of Pfizer's experiments were unsuccessful. The best that Pfizer could do was have its scientists speculate, ten years after the fact, that many different things *could have* gone wrong with all of its failed experiments (A. p. 135). Thus the fact remains that the Examiner would have rejected at least claim 1 had he but known that all of Pfizer's experiments had failed, and that there was no investigation which explained those failures.

[3]Pfizer's scientist Blackwood, a named alleged co-inventor, filed two affidavits (A. pp. 130-132). The first stated that he ". . . believed during prosecution of the application, and be-

(This footnote is continued on next page)



From these facts the District Court concluded that Pfizer's unsuccessful experimental efforts *were* material to the issue of whether or not broad process claim 1 was patentable, that Pfizer deliberately withheld its unsuccessful experiments from the Patent Office in violation of its duty of disclosure, and that "[b]*ut for* Pfizer's deliberate withholding of its unsuccessful efforts . . . the Doxycycline patent with at least broad process claim 1 would not have issued" (A. pp. 80-81, Conclusions 1-5; emphasis added).

Pfizer's "defense", both in the District Court and on appeal to the Eighth Circuit, was that its scientists believed in "good faith" that ruthenium would work as a catalyst.[3]

Consequently, if the Eighth Circuit's opinion is upheld and if the trier of fact determines that Pfizer's scientists truly entertained the belief "in good faith" that ruthenium would work as a catalyst, the patent (at least on this issue) may be valid[3a] *even though the Patent Office would not have granted the patent had it known the true facts.* Thus, despite the fact that the Patent Office is charged with the duty of determining the scope of the claims, and in this case would not have issued the broad claim actually granted, the abhorrent

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lieve[s] now, that ruthenium is operative . . ." as a catalyst. The second stated that he ". . . believed at the time the application was filed that ruthenium was operable as a catalyst . . ." In the second affidavit, Blackwood also characterized Pfizer's totally unsuccessful experiments as "unconclusive preliminary experiments" and declared, without saying when, that "I have made doxycycline using ruthenium as a catalyst." These additional conclusions and undated and unsupported pronouncements were properly disregarded by the District Court as insufficient generalizations (A. pp. 6-7 citing cases).

In an attempt to inject further confusion Pfizer's brief on appeal also cited three documents which it claimed "report the successful use of ruthenium" as a catalyst. These documents were not part of the record before the District Court or the Eighth Circuit and irrespective of what they really show must therefore be disregarded.

Thus the only evidence before the District Court or properly before the Eighth Circuit were Pfizer's contemporaneous reports which uncontrovertedly proved that *all* of Pfizer's experiments prior to issuance of the patent failed to successfully use ruthenium as a catalyst. (A. p. 78, findings 3-4, citing Exhibits 60, 62, 63 and 64 which state *e.g.*, "catalysts such as ruthenium . . . have failed to give the desired reaction."; "with ruthenium no conversion to [doxycycline] was observed." (On appeal, Pfizer also relied on one report stating that ". . . ruthenium [was] also tried as catalysts but effected little hydrogenation" (A. p. 135). Little hydrogenation cannot, of course, be expanded into saying that a little doxycycline was produced—and nothing in the record says that it can.)

[3a]Fraud or inequitable conduct in obtaining a single claim of a patent renders the entire patent invalid and unenforceable. *Marconi Wireless Telegraph v. United States,* 320 U.S. 1, 57-58 (1943).



result will be that Pfizer will be allowed to keep and assert that broad claim in spite of its deliberate breach of its fiduciary duty simply because its breach of that duty was "in good faith" and lacking in intent to commit a fraud.

It is therefore the Eighth Circuit and not the District Court that has created an "unworkable standard"—a standard which subverts the function of the Patent Office and thwarts the public policy of freeing competition from unwarranted patent monopolies.

### 3. Summary Judgment Is Proper Where the Court Can Readily Understand the Technology Involved Without Expert Testimony.

The great weight of authority permits summary judgment where the court can readily comprehend the technology without the aid of expert testimony and where summary judgment is otherwise proper. *Research Corporation v. Nasco Industries, Inc.*, 501 F.2d 358 (7th Cir. 1974), *cert. denied,* 95 S.Ct. 689 (1974); *Bobertz v. General Motors Corp.*, 228 F.2d 94 (6th Cir. 1955), *cert. denied,* 352 U.S. 824 (1956). In *Research Corporation* the court said at page 362:

> ". . . Rule 56 applies to patent cases . . . [where the technical issues] may be readily comprehended by the court . . . without need of technical explanation by expert witnesses."

In this case, the District Court, in setting forth the necessary technical facts, said that ". . . the technology necessary for a complete understanding of the uncontroverted facts is not overly difficult". (A. p. 9). In fact, the District Court drew its recitation of "The Facts Respecting Technical Terms and Concepts"

(A. pp. 27-32) from Pfizer's affidavits setting forth those facts. On appeal, neither party disputed the accuracy of those facts, and the Eighth Circuit apparently had no difficulty in either comprehending or reciting those technical facts. Indeed, in its Opinion, before correctly summarizing the relevant technology as "terminology and background", the Eighth Circuit characterized the pertinent technology as "undisputed background" (A. p. 107). Consequently, for the Eighth Circuit to ultimately conclude, in reversing the judgment, that unspecified "additional issues of technical fact are present that are unsuited for summary resolution without the benefit of live expert testimony and cross-examination in a plenary trial" is purely gratuitous and serves only to inject a phantom issue.

Equally gratuitous is the Eighth Circuit's comment that "genuine issues of material fact are present, concerning . . . the examiner's understanding of technical facts . . ." (A. p. 116). The Examiner submitted three affidavits, the first and third at the request of Pfizer, and the second at the request of the defendants. In those affidavits, he set forth in painstaking detail his "understanding of the technical facts" among other things. Neither party sought his live testimony; and the Eighth Circuit does not explain what, if anything, the Examiner's live testimony at trial (if available) could possibly add or subtract. Moreover, on appeal Pfizer did not contend that the Examiner's affidavit testimony was in any way obscure, or that his credibility was in issue. To the contrary, as shown in detail in footnote 1, *supra*, Pfizer's efforts were directed to semantic exercises employing the Examiner's inapplicable hypotheticals in an attempt to avoid the Examiner's unqualified testimony that had he but known certain



withheld facts, he would not have granted at least broad claim 1.

In short, the issues in this case are neither technology nor the Examiner's understanding or application thereof, but rather whether subjective intent to commit a fraud, is or is not a necessary element of proving or disproving fraudulent or inequitable conduct in procuring a patent.

## VII
## Conclusion.

It is therefore respectfully submitted that this Petition for a Writ of Certiorari should be granted to resolve the conflict between the Circuits as to whether subjective intent to commit a fraud on the Patent Office in prosecuting a patent application, is either an element of proof or a defense where the undisputed facts show that the patentee deliberately withheld and deliberately misrepresented facts which were material to patentability in the "but for" sense, the "materiality" sense, and also the "cumulative materiality" sense.

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Respectfully submitted,

PETER R. COHEN,
*Attorney for Petitioner.*